

REMARKS

Applicants acknowledge withdrawal of all previous grounds of rejection set forth in the Office Action dated December 6, 2000. Entirely new grounds of rejection have been raised against all pending claims. In view of the new grounds of rejection, Applicants are entitled to respond to the new grounds of rejection, including submitting Declarations under Rule 132. MPEP 716.01.

By this paper, claims 7, 8, 14, and 16 were amended. These claims were amended to refer to "one or more" bond gap spacers. Support for this amendment is found in the specification at page 6, line 11, which discloses a single bond gap spacer, i.e., weed trimmer line. Figure 1 also discloses a single bond gap spacer. Applicants submit that the foregoing amendment does not raise any issues that would prevent its entry under Rule 116. The amendment does not "[touch] the merits of the application ... under examination." Therefore, a showing under 37 CFR 1.116(c) is not required. It is merely a clarifying amendment with no substantive effect on the patentability issues raised in the Office Action. At most, it requires only "cursory review by the examiner" (MPEP 714.13); therefore, a showing under 37 CFR 1.116(b) is not required as stated in MPEP 714.13. Entry of this amendment is respectfully requested.

Section 103(a) Rejection of Claim 1. The Office Action rejected claim 1 under Section 103(a) as being obvious over Hying et al. in view of Dow Corning Datasheet (newly cited). According to the Office Action, it would have been obvious to replace the two-sided tape of Hying et al. with the elastomeric adhesive disclosed in the Dow Corning Datasheet.

From the Office Action and prior discussions with the Examiner, it appears the Examiner views the claimed invention as the trivial replacement of one adhesive with another adhesive. According to the Office Action, it would have been obvious to replace Hying's double-sided tape with any known and equivalent adhesive. In the present case, the Examiner's logic and reasoning is flawed because there is no evidence in the record that Dow Corning's catalyzed elastomeric adhesive was known to be equivalent and substitutable for Hying's conventional double-sided tape. Merely because Dow Corning's adhesive was commercially available does not mean that one skilled in the art knew it could be used to successfully fabricate an acrylic basketball backboard with "sufficient adhesion

and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball." Furthermore, merely because Dow Corning's adhesive was commercially available does not mean that one skilled in the art would have been motivated to substitute it for Hying's double-sided tape.

A significant part of the instant invention was Applicant's discovery that a catalyzed elastomeric adhesive could successfully replace conventional double-sided tape in fabricating acrylic basketball backboards. Since there is no evidence in the cited prior art that Dow Corning's elastomeric adhesive was a known substitute for Hying et al.'s double-sided tape, Applicant submits that Hying et al. and Dow Corning Datasheet fail to motivate one of ordinary skill in the art to combine the references as urged in the Office Action.

According to MPEP 2143, to establish *prima facie* obviousness, there must be some suggestion or motivation to modify the reference or to combine reference teachings to arrive at the claimed invention. "The teaching or suggestion to make the claimed combination ... must be found in the prior art, not in applicant's disclosure." MPEP 2143, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). In the present case, the prior art fails to suggest the desirability of the combination.

Only Applicant's specification suggests the desirability of the combination. The cited Hying and Dow Corning Datasheet references teach isolated claim limitations, but fail to disclose, suggest, or motivate modification of the Hying device to arrive at the claimed invention as a whole. It is "impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention." Uniroyal v. Rudkin-Wiley, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (citing W. L. Gore & Associates v. Garlock, Inc., 220 USPQ 303, 312). *Prima facie* obviousness requires that the prior art teach or suggest the whole invention as claimed. As the Federal Circuit has explained:

It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art. Bausch &

Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc., 796 F.2d 443, 448, 230 USPQ 416 (Fed. Cir. 1986) (quoting In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)).

The rejection of claim 1 is based on picking and choosing isolated teachings from the Hying and Dow Corning Datasheet references and pasting them together to recreate the claim. For instance, the Examiner relied upon Hying's disclosure of "prior art" double-sided tape (Figure 2, column 2, lines 15-16), but ignored the entire thrust of the Hying patent, which is that double-sided tape suffers from drawbacks and disadvantages, "[m]ost notably, ... the use of adhesive material, which may not be strong enough to retain the acrylic sheet against the frame for an extended period." Hying, column 2, lines 24-28. Hying's disclosed and claimed solution to the problem of doubled-sided tape is to use non-adhesive plastic retainers to hold the acrylic backboard. Hence, Hying "fairly suggests to one skilled in the art" to use non-adhesive plastic retainers to hold the acrylic backboard. There is absolutely no teaching or suggestion by Hying that double-sided tape should be replaced by a different adhesive, such as Dow Corning's adhesive.

Similarly, the Dow Corning Datasheet fails to teach or suggest using its elastomeric adhesive in place of double-sided tape. The Office Action states, without supporting evidence, that Applicant merely followed the manufacturer's instructions in fabricating acrylic backboards with catalyzed elastomeric adhesive. The Examiner is respectfully requested to identify "the instructions provided by the adhesive manufacturer" that teach and suggest using catalyzed elastomeric adhesive as a replacement for double-sided foam tape in basketball backboard systems. Applicant has carefully reviewed the Dow Corning Datasheet, and it does not contain any teaching or suggesting to use catalyzed elastomeric adhesive in place of double-sided tape.

Since there is no motivation or suggestion in the cited prior art to replace the double-sided tape of Hying's basketball backboard with the elastomeric adhesive of Dow Corning Datasheet, then *prima facie* obviousness under Section 103(a) has not been established. Applicant requests withdrawal of the rejection under Section 103(a) and allowance of claim 1 and its dependent claims.

Declaration of Jerry Ward. Since *prima facie* obviousness has not been established under Section 103(a), evidence of non-obviousness is not required. However, to reduce issues and expedite allowance of this application Applicant submits a Declaration of Jerry Ward under Rule 132 presenting evidence of unobvious benefits. The Declaration includes evidence that backboards fabricated with elastomeric adhesive perform substantially better than backboards fabricated with double-sided tape in basketball impact testing. See, Jerry Ward Declaration, ¶¶ 4-9. The impact results, combined with the torque deflection test described in the specification at pages 9 and 10, demonstrate that backboards fabricated using catalyzed elastomeric adhesive possess overall better adhesion, flexibility, and durability than conventional double-sided tape. Jerry Ward Declaration, ¶ 10. Applicant submits that this superior performance of the claimed acrylic basketball backboard assembly is evidence that the claimed invention would not obvious from the cited prior art. MPEP 716.02(a).

The Jerry Ward Declaration also contains evidence of substantial manufacturing cost savings associated with the claimed invention. For example, the assignee saves approximately \$3 per backboard in materials costs for each acrylic backboard fabricated using catalyzed elastomeric adhesive instead of conventional two-sided tape. In 2000 and 2001, this translates into a savings of about \$2,100,000 in materials costs with the manufacture of about 700,000 acrylic backboard basketball systems. Jerry Ward Declaration, ¶ 11. Applicant further submits that this impressive materials cost savings is evidence that the claimed invention would not obvious. MPEP 716.02(a).

There are significant labor savings when acrylic backboards are fabricated using catalyzed elastomeric adhesive. About 2400 acrylic backboards per day may be fabricated using twelve (12) people in three shifts using the catalyzed elastomeric adhesive process. In contrast, twenty-four (24) people in three shifts are required to fabricate 1800 acrylic backboards using the conventional two-sided tape system. The annual labor savings of about 62.5% represents a substantial cost savings. Applicant submits that the extraordinary labor savings associated with the present invention is evidence that the claimed invention would not obvious. MPEP 716.02(a).

Declaration of S. Curtis Nye. The Declaration includes evidence that Lifetime Products began selling acrylic basketball backboards fabricated with elastomeric adhesive in

about October 1999. See, S. Curtis Nye Declaration, ¶ 2. The Declaration further states that Huffey Sports, a division of Huffey Corporation, recently began selling acrylic basketball backboards fabricated with elastomeric adhesive. See, S. Curtis Nye Declaration, ¶ 3. Prior to this time, Huffey Sports used double-sided tape to fabricate acrylic backboards. Applicant submits that Huffey Sports has copied Applicant's invention, which is evidence of non-obviousness. MPEP 716.06.

Copying is particularly evident when one considers that the primary reference, Hying et al. (assigned to Huffey Corporation) teaches that plastic retainers should be used to fabricate acrylic backboards instead of double-sided tape. Huffey Sports recently replaced double-sided tape with elastomeric adhesive (not plastic retainers) after observing that Lifetime Products was able to successfully manufacture acrylic backboards fabricated with elastomeric adhesive.


In view of the foregoing evidence of non-obviousness, Applicant submits that claim 1 is in condition for allowance and respectfully requests such allowance.

Rejection of Claims 2-18 under Section 103(a). The Office Action rejected claims 2-18 under Section 103(a) as being obvious over Hying et al., in view of Dow Corning Datasheet, and further in view of Nunes and 3M data. These references were previously discussed by the Applicant in the Amendment and Response to Office Action dated March 6, 2001, which is incorporated herein. These references fail to disclose or suggest those features of the claimed invention that are lacking in the primary references. In view of the foregoing discussion relating to claim 1, Applicant submits that claims 2-18 would not have been obvious from the combined disclosure of the cited prior art. Applicant requests withdrawal of the rejection and allowance of claims 2-18.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

If there are any remaining issues preventing allowance of the foregoing claims, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "E. R. Witt", written over a horizontal line.

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Date: September 11, 2001

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Version with markings to show changes made.

Claims 7, 8, 14, and 16 have been amended as follows:

7. (amended) A basketball backboard assembly according to claim 1, further comprising [a plurality of] one or more bond gap spacers located between the frame bonding surface and the backboard bonding surface to provide a defined bond gap.

8. (amended) A basketball backboard assembly according to claim 7, wherein the [plurality of] one or more bond gap spacers comprise spherical beads.

14. (twice amended) A basketball backboard assembly sized and configured for playing the game of basketball comprising:
a metal backboard frame structure having a bonding surface;
an acrylic backboard having a bonding surface; and
a catalyzed silicone adhesive sandwiched between the frame bonding surface and the backboard bonding surface, wherein the silicone adhesive has a bond gap in the range from about 2 to 2.5 mm, wherein the silicone adhesive is configured to provide a set time in the range from about 5 minutes to 1 hour, wherein the silicone adhesive provides sufficient adhesion and flexibility to the acrylic backboard and frame structure bonding surfaces to be used in the game of basketball; and
[a plurality of] one or more bond gap spacers located between the frame bonding surface and the backboard bonding surface to provide the bond gap.

16. (amended) A basketball backboard assembly according to claim 14, wherein the [plurality of] one or more bond gap spacers comprise spherical beads.